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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,985	01/19/2001	Michael A. Sharp	65-1	1204

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MICHAEL SHARP
P O BOX 101
PORTER, TX 77365

EXAMINER	
MYHRE, JAMES W	
ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/765,985	SHARP, MICHAEL A.	
	Examiner	Art Unit	
	JAMES W. MYHRE	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 December 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the amendment filed on December 2, 2007. The amendment cancelled Claims 1-4, amended Claims 5 and 8-10, and added new Claims 11-29. Therefore, the currently pending claims considered below are Claims 5-29.

Information Disclosure Statement

2. The information disclosure statement filed on November 1, 2007 incorporating the references cited in the specification has been entered and considered. A copy of the completed Form 1449 is attached.

Claim Objections

3. The amendment filed on December 2, 2007 corrected the deficiencies in Claim 8 noted in the Office Action of August 2, 2007. Thus, the Examiner hereby withdraws that objection.

Specification

4. The new Abstract and Specification submitted on December 2, 2007 overcomes the objections noted in the Office Action of August 2, 2007. Thus, the Examiner hereby withdraws that objection

Drawings

5. The new drawings submitted on December 2, 2007 have overcome the objections to the drawings noted in the Office Action of August 2, 2007. Thus, the Examiner hereby withdraws those objections.

Claim Rejections - 35 USC § 101

6. The Amendment filed on December 2, 2007 canceled Claims 1-4 that were rejected as being non-statutory in the Office Action of August 2, 2007. Thus, the Examiner hereby withdraws that rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 5-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (5,931,901) in view of Weisberg et al (6,351,736).

Claims 5 and 14: Wolfe discloses a service and method for distributing advertising, comprising combining an advertising message data file with a musical composition data file (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5) and

further discloses encrypting the file so that the user "can not separate the music from the advertising copy and/or copy it for their personal use or dissemination, in violation of licensing terms" (column 6, lines 7-12). While Wolfe does not explicitly disclose that the combined file is downloaded and stored on the user device, the disclosure that the user may attempt to disseminate the file at least implies that it has been stored on the user device. Furthermore, Weisberg discloses a similar method for combining an audio file and an advertisement into one file (column 6, lines 62-65) that is downloaded "then optionally stored on the computer of the user" (column 4, lines 19-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Wolfe to store the incoming combined data file. One would have been motivated to store the file in order to facilitate the user ordering the advertised item as discussed in Wolfe (column 6, lines 14-20).

Claims 6 and 7: Wolfe and Weisberg disclose a method as in Claim 5 above that combines the advertising data file with the music data file, but do not explicitly disclose the type of editor doing the combining. As discussed by the Applicant, both sound editors and hexadecimal editors (e.g. HEX editor A.X.E.) were known at the time the invention was made (page 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use known editors, such as sound or Hexadecimal editors, to combine the data files in Wolfe. One would have been motivated to use either of these known editors in order to efficiently combine the files without having to develop your own editor.

Claim 8: Wolfe discloses a method for distributing music, comprising:

a. receiving licensed multimedia files (column 4, lines 18-25 and column 5, lines 26-44);

b. combining a multimedia file with an advertising data file and licensing data (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5);

c. sending the combined file to end users (column 2, line 60 – column 3, line 3; column 6, line 21 – column 7, line 5; and column 7, lines 39-64); and

d. charging fees to the advertiser providing the advertising file (column 4, lines 18-25 and column 5, lines 26-44).

While Wolfe does not explicitly disclose that the combined file is downloaded and stored on the user device, the disclosure that the user may attempt to disseminate the file at least implies that it has been stored on the user device. Furthermore, Weisberg discloses a similar method for combining an audio file and an advertisement into one file (column 6, lines 62-65) that is downloaded "then optionally stored on the computer of the user" (column 4, lines 19-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Wolfe to store the incoming combined data file. One would have been motivated to store the file in order to facilitate the user ordering the advertised item as discussed in Wolfe (column 6, lines 14-20).

Claims 9 and 22: Wolfe and Weisberg disclose a service and method as in Claims 8 and 14 above and Wolfe further discloses the multimedia file comprises a musical composition/performance (column 2, lines 18-30 and column 4, lines 18-25).

Claims 10 and 23: Wolfe and Weisberg disclose a service and method as in Claims 8 and 14 above, and Weisberg further discloses using files in wav, MP3, or compressed formats (column 1, lines 24-27 and column 5, lines 37-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to format the data file in Wolfe using any of the standard formats known at the time to include wav, MP3, or other compression formats. One would have been motivated to use such compression formats in order to reduce the amount of bandwidth needed to transmit these large audio files such as discussed by Weisberg.

Claims 11, 15, and 16: Wolfe and Weisberg disclose a service and method as in Claims 8 and 14 above, and Wolfe further discloses determining royalty fees due to the owner of the audio file based on the "play" statistics (column 5, lines 34-37).

Claims 12 and 13: Wolfe and Weisberg disclose a method as in Claim 8 above, and Wolfe further discloses the advertiser paying for (i.e. selecting) including the advertising message with specific musical profile (i.e. genre of music) (column 3, lines 56-61). While it is not explicitly disclosed that the advertiser provides a list of specific audio files (e.g. song titles), it would have been obvious to one having ordinary skill in the art at the

time the invention was made for the advertiser in Wolfe to do so. One would have been motivated to receive a list of specific files with which to associate an advertisement in order to allow the advertiser to better target their advertisement, e.g. Ford Motor Company advertising its Mustang sports car during the playing of the song, "Mustang Sally".

Claims 17-19: Wolfe and Weisberg disclose a service as in Claim 14 above, and Wolfe further discloses the sponsor of the message is someone who has paid the web site operator to embed the message into the audio file (i.e. an advertiser) and who is someone other than the web site operator or the artist/author of the audio file (column 4, lines 7-59).

Claim 20: Wolfe and Weisberg disclose a service as in Claim 14 above, and Wolfe further discloses the web site is configured to accept uploads of audio files and sponsor messages (column 3, lines 33-46).

Claim 21: Wolfe and Weisberg disclose the service as in Claim 20 above, and Wolfe further discloses embedding the message into the audio file before it is downloaded to the user device (column 2, line 60 – column 3, line 3).

Claim 24: Wolfe discloses a method comprising:

downloading an audio file with an audible advertisement from a web site to a user's computer (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5) and Weisberg discloses a similar method for combining an audio file and an advertisement into one file (column 6, lines 62-65) that is downloaded "then optionally stored on the computer of the user" (column 4, lines 19-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Wolfe to store the incoming combined data file. One would have been motivated to store the file in order to facilitate the user ordering the advertised item as discussed in Wolfe (column 6, lines 14-20).

While it is not explicitly disclosed that the combined audio file is transferred to an external playing device, Weisberg does disclose that "audio data are stored on many different types of media in many different formats, and are then played by different audio players" (column 1, lines 11-13). Official Notice is taken that it is old and well known within the computer industry that both locally stored files and incoming data stream files may be transferred to removable storage devices, such as CD-ROMs, smart cards, tape, etc. For example, users have been recording radio and television broadcasts onto audio tapes for years. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the user in Wolfe to save the incoming data stream (or the locally stored file in Weisberg) onto a removable storage medium such as a disc or smart cart that may be played on an external playing device (e.g. PDA, cell phone, etc.). One would have been motivated to

store the combined file onto a removable storage medium in order to allow the user to listen to the audio file at the desired time and location.

Claim 25: Wolfe and Weisberg disclose a method as in Claim 24 above, and Wolfe further discloses that the audio file and the advertisement are delivered in an inseparable stream (column 3, line 1-3). Thus, the advertisement would inherently play each time the audio file is played.

Claim 26: Wolfe and Weisberg disclose a method as in Claim 25 above, and Wolfe further discloses that the audio file is a song or single (column 2, lines 18-30 and column 4, lines 18-25).

Claim 27: Wolfe and Weisberg disclose a method as in Claim 24 above, and Wolfe further discloses the sponsor of the message is someone who has paid the web site operator to embed the message into the audio file (i.e. an advertiser) and who is someone other than the web site operator or the artist/author of the audio file (column 4, lines 7-59).

Claim 28: Wolfe and Weisberg disclose a method as in Claim 27 above, and Wolfe further discloses that the advertisement is appended to the beginning of the audio file ("leader") prior to being made available for downloading (column 6, lines 32-39).

Claim 29: Wolfe and Weisberg disclose a method as in Claim 24 above, and Weisberg further discloses using files in wav, MP3, or compressed formats (column 1, lines 24-27 and column 5, lines 37-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to format the data file in Wolfe using any of the standard formats known at the time to include wav, MP3, or other compression formats. One would have been motivated to use such compression formats in order to reduce the amount of bandwidth needed to transmit these large audio files such as discussed by Weisberg.

Response to Arguments

9. Applicant's arguments with respect to claims 5-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
January 10, 2008

/James W Myhre/
Examiner, Art Unit 3622